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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,665	03/27/2007	Daisuke Macjima	U 016319-1	5022
140	7590	09/30/2010		
LADAS & PARRY LLP 26 WEST 61ST STREET NEW YORK, NY 10023				
EXAMINER				
DEGUIRE, KATHERINE E				
ART UNIT		PAPER NUMBER		
1781				
NOTIFICATION DATE		DELIVERY MODE		
09/30/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

nyuspatactions@ladas.com

Office Action Summary

Application No.

10/580,665

Applicant(s)

MAEJIMA ET AL.

Examiner

Katherine DeGuire

Art Unit

1781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 21 and 23-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 21 and 23-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12, 21, 23-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "oil/fat" as amended by the applicant is unclear because oil and fat are not necessarily the same components. Oil is a subset of fat, in particular a liquid fat. "Fat" includes both liquid and solid fat and thus encompasses a wider scope than the term "oil". Thus, if the term "oil/fat" is intended to mean that the components are synonyms, the claim is then contradictory. Furthermore, it is unclear if only fats that are oils are required in the claim, or if any fat component is acceptable.

All remaining 112 second paragraph rejections from the previous action are withdrawn due to applicant's amendments.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,3-12, 21, 23-25, 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim(US 4,442,132) in view of Avera(US 5,436,023).

Regarding claims 1 and 21, Kim teaches the limitations as previously presented. Kim does not specifically teach that the stirring of the first mixture is carried out under heating conditions of 40 to 60C. However, Kim teaches that the starting materials of hazelnuts and lactitol monohydrate are blended and ground in an almond mill. The grinding in the almond mill would inherently produce heat from the friction. Since room temperature is typically 25C, one of ordinary skill in the art would expect the temperature to rise up to 40C to 60C upon enough friction from grinding the hazelnuts.

Avera teaches a method of roasting food slurries, especially nut slurries like peanut butter (column 2, line 33-43). Avera teaches using a high friction grinder to roast the food slurry up to a temperature of 340 to 400F (171 to 204C) (column 4, line 42-60). Thus, Avera demonstrates that the friction from grinding can increase the temperature of the nut composition by a significant amount if desired. Based on the teachings of Avera, one of ordinary skill in the art would expect that the temperature of the ground hazelnuts in Kim to increase to the range of 40 to 60C during grinding.

For example, Kim teaches that the grinding is to be carried out gradually in order to avoid the liberation of oil. Thus, one of ordinary skill would expect the grinding process to be mild enough to not reach the high temperature of 340 to 400F as disclosed in Avera. Avera specifically teaches roasting while Kim only seeks to grind the nut to a size of 0.7mm. Thus, one of ordinary skill in the art would expect Kim to control the grinding process to a more mild temperature of 40 to 60C, especially since it is known in the art that grinding can produce high temperatures if not monitored.

Furthermore, it would have been obvious to control grinding process in order to not burn the mixture from the temperature produced by the friction.

Regarding claim 31 and 32, Kim and Avera teach the process of claim 21, including the step of stirring the finely ground mixture while heating between a temperature of 40 to 60C. One of ordinary skill in the art would expect a product formed by the process of claim 31 would have the associated properties of that claim, specifically a protein concentration of at least 15% and a softness or chewability that is enhanced as compared with a softness or chewability of the high-protein baked food product if prepared with the same components but without the step(ii) of forming the creamy primary product and mixing the creamy primary product with the second material mixture before baking.

Regarding claims 3-12,23-25,27-30, Kim is cited in the previous action.

Claims 2 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view Avera further in view of Titcomb(US 3,987,206).

The claims remain rejected for the reasons set forth in the previous action.

Response to Arguments

Applicant's arguments filed 07/06/2010 have been fully considered but they are not persuasive.

The applicant argues that Kim does not teach stirring. However, Kim teaches grinding the lactitol and hazelnuts together in the first step. This process grinds and

mixes the two components together. According to Meriam Webster's dictionary, the definition of "stirring" is "to disturb the relative position of the particles or parts of especially by a continued circular movement." The process of grinding and mixing is a continuous circular movement that would disturb the position of the composition particles. Thus, the process of grinding and mixing would also meet the definition of "stirring."

The applicant argues that Kim does not teach stirring at a temperature of 40 to 60C. However, as evidenced by Avera, it would have been obvious that the first mixture would be heated to a temperature of 40 to 60C from the friction of the grinding mill. The applicant argues that the almond mill would not produce the temperatures as claimed. However, the applicant has not provided evidence to support this statement.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine DeGuire whose telephone number is (571)270-1136. The examiner can normally be reached on Monday through Friday 9-5:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Katherine DeGuire/
Examiner, Art Unit 1781

/Keith D. Hendricks/
Supervisory Patent Examiner, Art Unit 1781